

REMARKS

The Applicant has carefully considered the Office action dated August 12, 2009. The Applicant respectfully traverses the rejections and submits that all claims are in condition for allowance. Favorable reconsideration and allowance of this application are respectfully requested.

I. The Rejection under 35 USC § 112, Second Paragraph

Claim 20 was rejected under 35 USC § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention. In particular, the Office action indicated that the recitation of “the feed conveyor” lacked antecedent basis. By way of this response, the Applicant has amended the two recitations of “the feed conveyor” to “the conveyor” in claim 20. Antecedent basis for “the conveyor” can be found in claim 16. Accordingly, the Applicant respectfully requests withdrawal of the § 112 rejection from claim 20.

II. The Rejection under the Recapture Rule

Claims 16-34 were rejected under 35 USC § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. Claims 16-34 do not improperly recapture subject matter previously surrendered as defined by the recapture rule. In particular, the amendments during the original prosecution that are cited in the Office action as violating the recapture rule were not made to overcome prior art and, thus, are not subject to the recapture rule.

The Office action suggests that claim 16 violates the recapture rule because claim 1 recites the control system operatively connected to packer boxes and operatively connected to feeder boxes, while claim 16 does not require the controller to be operatively connected to packer boxes or feeder boxes. However, the omission of such features from claim 16 does not amount to recapture.

The recapture rule seeks to prevent patentees from recapturing subject matter previously surrendered to overcome prior art in the prosecution of the application that matured into the patent for which reissue is sought. *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 1350 (Fed. Cir. 2005). Surrendered subject matter arises from amendments or arguments made during the prosecution history of the patent to overcome prior art. *Id.*, (Applicant amended and argued that the amended claim defined over the prior art.); *and see MPEP* § 1412.02(I)(B)(1) (“The reliance by applicant to define the

original patent claims over the art can be by presentation of new/amended claims to define over the art, or an argument/statement by applicant that a limitation of the claim(s) defines over the art.") (emphasis added); *and see Kim v. ConAgra Foods, Inc.*, 465 F.3d 1312, 1323 (Fed. Cir. 2006) ("It is clear that in determining whether "surrender" of subject matter has occurred, the proper inquiry is whether an objective observer viewing the prosecution history would conclude that the purpose of the patentee's amendment or argument was to overcome prior art and secure the patent.") (emphasis added).

During prosecution of Application Serial No. 09/073,487 (the '487 application), which matured into the patent that is the subject of this reissue, original claim 1 recited "a primary controller for activating of the packer boxes..., the controller further for activating a selected one of the feeder boxes..." *See the '487 application filed May 6, 1998*, Original Claim 1. Claim 1 was rejected under 35 USC § 112, first paragraph, alleging that the specification did not reasonably provide enablement for a primary controller which activates a feeder box. *See Office Action dated January 11, 2000, of the '487 Application*, p. 3. The Office action suggested that the specification did enable a primary controller operatively connected to a feeder controller. *Id.*

In response to the § 112 rejection in the Office action of January 11, 2000, the Applicant amended claim 1 to recite "a control system operatively connected to the packer boxes..., the control system further being operatively connected to the feeder boxes..." *See Applicant's Response submitted on June 12, 2000*, p. 2, claim 1 and p. 3, remarks. This amendment was not made to overcome prior art. Accordingly, it is not surrendered subject matter within the meaning of the recapture rule.

In the remarks section of the Applicant's response of June 12, 2000, the Applicant did not argue the control system to secure the patent. Instead, the Applicant indicated that "[t]he combination [of Magee et al. (US 5,458,323) and Newsome (US 5,088,711)] completely fails to teach or even suggest the claimed feeder system associated with at least one of the packer boxes, with the feeder system having a plurality of feeder boxes and a feed conveyor such that a selected one of the feeder boxes may be activated to deliver a distinct signature to the associated packer box for insertion into the binding line." *Id.*, p. 4, ¶ 3. Thus, the Applicant did not argue that the control system recited in claim 1 patentably distinguished claim 1 from the prior art. Thus, neither the control system nor how it is operatively connected amounts to surrendered subject matter.

In addition, none of the remarks in the Applicant's response of June 12, 2000, related to independent claims 7 and 14 amounted to arguments distinguishing over the prior art based on a control system or controller operatively connected to packer boxes and feeder boxes. *Id.*, p. 5 (concerning claim 7, "There is no plurality of feeder boxes associated with any one of the packer boxes, and hence the combination [of Magee et al. and Newsome et al.] would not be capable of delivering distinct signatures from one of a plurality of feeder boxes to a packer box.") and p. 6 (concerning claim 14, "The cited combination [of Magee et al. and Newsome et al.] completely fails to teach or even suggest providing a plurality of feeder boxes to feed one of the packer boxes.").

In view of the foregoing, the omission from claim 16 of a control system operatively connected to packer boxes and feeder boxes does not amount to recapture in violation of the recapture rule.

In addition, the Applicant submits that none of independent claims 21, 27, and 31 are in violation of the recapture rule. No reasons to the contrary were offered in the Office action of August 12, 2009, of the instant reissue application.

III. Conclusion

In view of the foregoing, the Applicant respectfully submits that this application is in condition for allowance and requests an early favorable notification to that effect. If there are any remaining matters that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

In general, the Office action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if any such statement should become relevant by appearing in a rejection of any current or future claim).

The Commissioner is hereby authorized to charge any deficiency in the amount submitted or any additional fees which may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 50-2455. Please refund any overpayment to Hanley, Flight & Zimmerman, LLC, at the address below.

In addition, if a petition for an extension of time under 37 CFR 1.136(a) is necessary to maintain the pendency of this case and is not otherwise requested in this case, the Applicant requests that the Commissioner consider this paper to be a petition for an

appropriate extension of time and hereby authorize the Commissioner to charge the fee as set forth in 37 CFR 1.17(a) corresponding to the needed extension of time to the above deposit account.

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Respectfully submitted,

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